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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CHANNAVAJJALA, LAKSHMI SARADA	
ART UNIT	PAPER NUMBER
1611	

MAIL DATE	DELIVERY MODE
04/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,949	Blin et al.	
	Examiner	Art Unit	
	Lakshmi S. Channavajjala	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-64* is/are pending in the application.

4a) Of the above claim(s) *28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-27 and 31-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11-2-04, 4-27-07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt of response dated 1-2-08 is acknowledged.

Claims 1-64 are pending.

Election/Restrictions

1. Applicant's election of Species I and sub-species of poly(methyl acrylate/acrylic acid) in the reply filed on 1-2-08 is acknowledged. Applicants elected the claims with traverse but not distinctly and specifically point out the supposed errors in the restriction requirement. Therefore, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-27 and 31-64 are considered for examination. Claims 28-30 are withdrawn as being non-elected.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1- 27 and 31-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2782917 (FR) and WO 02/067877 (WO), both submitted on PTO-1449.

6. FR teaches a Cosmetic composition for application onto skin and/or lips and/or keratin fibers contains polymeric system (I) comprising at least one dispersion of particles of film-forming polymer in aqueous phase and at least one fat substance liquid at ambient temperature and dispersed in aqueous phase. FR teaches that cosmetic composition for application onto skin and/or lips and/or keratin fibers contains polymeric system (I) comprising at least one dispersion of particles (5-500 nm, preferably 20-150 nm) of film-forming polymer in aqueous phase and at least one fat substance liquid at ambient temperature and dispersed in aqueous phase, in amount sufficient to form a film capable to follow natural movement of skin and/or lips and/or keratin fibers onto which it is applied. The film is preferably non- transferable.

7. The preferred components of FR include film-forming polymer is selected from anionic, cationic, non-ionic or amphoteric polyurethanes; acrylic-, polyvinyl-pyrrolidone-, polyester-, polyurea- and polyether- polyurethanes; polyesters, fat chain polyesters and polyester amides; polyamides; epoxyester resins; acrylic and/or vinyl polymers and/or copolymers; acrylic/silicone copolymers; natural origin, optionally modified polymers; polymers obtained by polymerization of one or more (internally and/or partially surface-) radical monomers, with pre-existing particles of at least one polymer selected from

polyurethanes, polyurea, polyesters, polyester amides and/or alkyds; and their mixtures. Preferably, film-forming polymer is obtained by polymerization of ethylenically unsaturated monomer, and is selected from methacrylic, vinyl, styrene and methacrylate polymers, and their mixtures. The composition preferably contains at least one polyurethane with oxyethylated alkyl end groups to promote dispersing of liquid fat component in aqueous phase. Preferred Product: The film produced by polymeric system contained in composition which has preferably glass transition temperature below 10 degrees C (especially below 0 degrees C) has elongation above 200% (preferably above 400%), hardness below 110 (preferably below 55) and Young module below 200 MPa (preferably below 80 MPa). FR states that the fat component is preferably selected from animal origin hydrocarbon oils, linear or branched hydrocarbons of mineral or synthetic origin, vegetable origin oils or triglycerides of caprylic/capric acids, esters of lanolinic, oleic, lauric and stearic acids, esters and ethers of synthetic fatty acids, hydroxylated esters, polyol esters, higher fatty acids, 10-30C higher fatty alcohols, silicone oils volatile or non-volatile at ambient temperature, fluorinated silicone oils, perfluorinated oils, and their mixtures, and it is preferably selected from hydrocarbons, fatty alcohols and oils of vegetable origin, and especially from squalane, apricot kernel oil and octyl dodecanol.

8. The composition preferably contains 1-45 wt.% (preferably 4-20 wt.%) of polymer component and 0.5-35 wt.% (preferably 5-15 wt.%) of fat component, and additionally contains at least one fat-soluble or water-soluble colorant and at least one pigment. Polymeric system may additionally contain auxiliary film-formation promoting agent, at

least one agent promoting emulsifying and/or dispersing of liquid fat component in aqueous phase. The independent claims of FR are for: (1) The use of sufficient amount of polymeric system (I) as claimed, in cosmetic or dermatological composition, to reduce or eliminate transfer of formed film from skin and/or lips and/or keratin tissue onto material brought into contact with film; (2) the use of polymeric system (I) as claimed to produce supple, brilliant and long lasting film, which leave no traces and/or shows no migration effect and/or is resistant to water; (3) cosmetic procedure for applying conditioning treatment or make-up using composition as claimed; and (4) device for packaging and application of composition as claimed, comprising reservoir containing the composition, with cap, provided with means of application, which can be air-tight fixed on the reservoir. FR teaches the use of the composition for cosmetic industry, as make-up product for use as lipstick, eye liner, mascara, foundation etc.

FR does not teach the claimed silicone polymers of claim 1 and the gelling agents. However, FR teaches that the composition is non-transferable (when used e.g. in lipstick, it does not leave traces on glass, skin or textiles), produces brilliant shine, shows no migration effect (when used as lipstick, there is no migration of color into small wrinkles around the lip contour), has long-term holding power, is resistant to water, comfortable to wear, and can be removed using wide range of existing make-up removers.

WO is also directed to a transfer resistant lipstick composition. The invention of WO comprises a method for improving the aesthetics of a pigmented transfer resistant film on the lips comprising coating the transfer resistant film with a non-reactive wetting

agent composition. The wetting agent composition serves to wet the transfer resistant film, which in turn provides improved hydration, comfort, and wear to the composition on the lips. The invention also comprises a method for wetting a pigmented transfer resistant film on the lips; comprising coating said transfer resistant film a non-reactive wetting agent composition that serves to wet the transfer resistant film. The composition comprises a volatile solvent (pages 9-13) in combination pigment particles (page 6, Last paragraph), polymeric film-former such as silicones, natural polymers (page 7), where WO describes high molecular weight silicones (page 8) and read on component B of the composition. WO teaches the same volatile solvents of instant application. Further, WO teaches gelling agents to improve the viscosity of the transfer resistant composition (page 14) and meet the claims 45-50. WO teaches two pack system and states that lips are first treated with lip composition, allowed to dry and then treated with wetting composition (pages 15 +). Example 3 shows the lip composition with the overcoat composition (which read on the instant first and second compositions respectively). WO fails to teach particulate polymeric materials of the instant first composition and FR fails to teach the high molecular weight silicone polymers. However, both the references are directed towards transfer resistant compositions that are suitable for cosmetic applications such as lips, skin, nails etc. WO states that the transfer resistance is afforded by the high molecular weight silicone films and provides long wear and resists transfer. Ion the other hand FR also teaches that the composition eliminates transfer of the films formed by the polymers and provides supple, long lasting and brilliant films.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21,279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach silicone polymers and polymer particles as effective ingredients in compositions for achieving transfer resistance, it would have been obvious to combine teachings of WO and FR to arrive at the instant composition with the expectation that such a combination would be effective in providing a transfer resistant composition. Thus, combining them flows logically from their having been individually taught in prior art. With respect to the specific silicones, molecular weight etc., WO also teaches fluorosilicoens (of instant claim 20) in example 4. WO also suggests applying the composition as a two-coat system and therefore meets the instant method steps of claims 63-64. While the abstract of FR (provided on PTO-1449) fails to teach the amounts of polymer particulate material, choosing an optimum amount so as to achieve the desired migration resistant would have been within the scope of a skilled artisan. For the specific dependent claims reciting volatile oils, pigments, gelling agents etc., WO suggests all of the claimed components and hence choosing the appropriate amounts so as to achieve the art recognized effect would have been the scope of a skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
March 31, 2008